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**BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES**

Application Number: 10/741,799  
Filing Date: December 19, 2003  
Appellant(s): CREAMER ET AL.

\_\_\_\_\_  
Steven M. Greenberg  
For Appellant

**EXAMINER'S ANSWER**

This is in response to the appeal brief filed 05/11/2009 appealing from the Office action mailed December, 11, 2008.

**(1) Real Party in Interest**

A statement identifying by name the real party in interest is contained in the brief.

**(2) Related Appeals and Interferences**

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

**(3) Status of Claims**

The statement of the status of claims contained in the brief is correct.

**(4) Status of Amendments After Final**

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

**(5) Summary of Claimed Subject Matter**

The summary of claimed subject matter contained in the brief is correct.

**(6) Grounds of Rejection to be Reviewed on Appeal**

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

**(7) Claims Appendix**

The copy of the appealed claims contained in the Appendix to the brief is correct.

**(8) Evidence Relied Upon**

**(9) Grounds of Rejection**

The following ground(s) of rejection are applicable to the appealed claims:

***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 8-13 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claims contain subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Independent claim 8 recites “**machine readable storage having stored thereon a computer program for managing subscriber services**”. [Emphasis added]. The specification does not support this limitation.

Dependent claims 9-13 are rejected for the same reason addressed in independent claim 8.

***Claim Rejections - 35 USC § 103***

Claims 1-6 and 8-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Friedman et al. (Pub. No.: 2008/0294977).

Regarding claims 1 and 8, Friedman teaches in a web browser, a shopper can access a web site vendor (i.e., eCommerce) to select and purchase a product and provide payment and delivery instructions [0005]. Shopper's identity can be retrieved from previous data regarding the user or the products that are stored in the system [0098 and 0077], thus there is no need for the shopper or the user of the eCommerce vendor to provide the information again. Also, Friedman teaches that the system can manage the delivery instructions by retrieving customer's data and information without the need to have the user provide this information [0077 and 0082].

The use of an IVR 285 is already taught in Friedman [see 0144-0145]. Also, certain embodiments [0112] teach that a user can be prompted to enter appropriate information.

However, Friedman does not specifically teach to "prompt a customer through an established telephone call to manage delivery instruction".

Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have an IVR, as the one taught by Friedman, prompt a customer or user to enter or respond to any type of information desired (such as, instructions, contact information, other type of identifications). An IVR can be customized to present and guide the user to reply to different types of questions and information. Since

Friedman teaches the use of an IVR, having the IVR prompt the customer to provide or enter any type of information is to apply a known technique to a known device ready for improvement to yield predictable results (see KSR – MPEP 2143). For example, an IVR can prompt the caller to provide any delivery instructions such as time, place, and/or direction to a specific address.

Regarding claims 2 and 9, the claimed feature of “change said delivery instructions” basically reads on the user making any changes to their order [0145 and 0238].

Regarding claims 3 and 10, Friedman teaches that that service application 214 can actually change the location without relying on customer’s phone call information [0157 and 0238].

Claims 4 and 11 are rejected for the same reasons as discussed above with respect to claims 3 and 10.

For claims 5 and 12, Friedman teaches live communication between users and sales associates [0145].

For claims 6 and 13, Friedman teaches charging the user [see 0005 and Fig. 7 steps 746-750 for billing].

***Claim Rejections - 35 USC § 102***

Claim 7 is rejected under 35 U.S.C. 102(e) as being anticipated by Friedman et al. (Pub. No.: 2008/0294977).

Regarding claim 7, Friedman teaches in a web browser, a shopper can access a web site vendor (i.e., eCommerce) to select and purchase a product and provide payment and delivery instructions [0005]. Shopper's identity can be retrieved from previous data regarding the user or the products that are stored in the system [0098 and 0077], thus there is no need to the shopper or the user of the eCommerce vendor to provide these information again. Also, Friedman teaches that the system can manage the delivery instruction by retrieving customer's data and information without the need to have the user provide these information [0077 and 0082]. The claimed "PSTN" as recited in claim 7 is already taught in Friedman [see 0161 discussion]. Also, the claimed "logic" reads on the logic and software taught by Friedman as discussed in [0238].

**(10) Response to Argument**

For Appellant's argument (Brief, pages 5-6) that is directed to the claimed "machine readable storage" as recited in claim 8, Appellant stated that Examiner's attention should be directed to paragraphs [0039] through [0041] which state :

[0039] The present invention can be realized in hardware, software, or a combination of hardware and software. An implementation of the method and system of the present invention can be realized in a centralized fashion in one computer system, or in a

distributed fashion where different elements are spread across several interconnected computer systems. Any kind of computer system, or other apparatus adapted for carrying out the methods described herein, is suited to perform the functions described herein.

[0040] A typical combination of hardware and software could be a general purpose computer system with a computer program that, when being loaded and executed, controls the computer system such that it carries out the methods described herein. The present invention can also be embedded in a computer program product, which comprises all the features enabling the implementation of the methods described herein, and which, when loaded in a computer system is able to carry out these methods.

[0041] Computer program or application in the present context means any expression, in any language, code or notation, of a set of instructions intended to cause a system having an information processing capability to perform a particular function either directly or after either or both of the following a) conversion to another language, code or notation; b) reproduction in a different material form. Significantly, this invention can be embodied in other specific forms without departing from the spirit or essential attributes thereof, and accordingly, reference should be had to the following claims, rather than to the foregoing specification, as indicating the scope of the invention.

[Emphasis added to the above paragraphs].

First, in the above identified paragraphs, it is clearly shown that what was claimed is a computer system and a computer program, which is completely different than a machine. Thus, the word "machine" is not mentioned anywhere in Appellant's specification. Second, the term "machine" is broad and it can be read on any type of machine such as a bar code reader and the like which are not



supported by the specification. However, the computer is a very specific. Thus, a machine is not the same as a computer.

Also, for Appellant's arguments (Brief, pages 7-9), Appellant states that "the notion of an IVR system- indeed the term IVR --is wholly absent in U.S. Patent Application Ser. No. 09/420,434. As such, the teachings of paragraphs [0144] and [0145] are to be considered "new matter" with respect to Friedman and cannot enjoy the priority date of U.S. Patent Application Ser. No. 09/420,434". First, Appellant is reminded that Friedman is also entitled to application No. 10/647,705 with the filing date of August 25, 2003 (i.e., 4 months earlier than Appellant's filing date). Application No. 10/647,705 which is now patent No. 7,370,076 actually teaches the use of IVR (element 285) as fully described in [0184]. Second, Appellant adds that "the concept of prompting a customer within an IVR system is wholly absent in U.S. Patent Application Ser. No. 09/420,434 and U.S. Patent Application Ser. No. 60/405,510—the provisional application". However, the use of an IVR (Interactive Voice Response) is old and well known in the art of telephony. As a matter of fact, according to the **Newton's Telecom Dictionary**, sixth edition, August 1993, the IVR was defined as:

"**IVR** Interactive Voice Response. Think of IVR as a voice computer. Where a computer has a keyboard for entering information, an IVR uses remote touchtone telephones. Where a computer has a screen for showing the results, an IVR uses a digitized voice to 'read' the screen to the distant caller. Whatever a computer

can do, an IVR can too, from looking up train timetables to moving calls around an automatic call distributor (ACD)".

Thus, with the use of IVR, the caller or customer can be prompted to enter any type of information. This is analogous to the claimed invention where the customer is prompted to manage providing delivery instructions.

Regarding Appellant's argument for the rejections of 35 U.S.C 102 (e), Appellant is reminded again that Friedman is entitled to application No. 10/647,705 with the filing date of August 25, 2003 (i.e., 4 months earlier than Appellant's filing date).

**(11) Related Proceeding(s) Appendix**

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,  
Primary Examiner  
Rasha S. Al-Aubaidi  
August 27, 2009

Art Unit: 2614

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